

Remarks

The final Office Action dated February 20, 2009 lists the following new rejections: claims 1-3, 5, 10, 12, 17, 19-21, 23-24, 26-27 and 29-30 stand rejected under 35 U.S.C. § 102(e) over Griffith (U.S. Patent No. 6,842,647); claims 4 and 22 stand rejected under U.S.C. § 103(a) over the '647 reference in view of Engebretson (U.S. Patent No. 5,475,759); claims 11, 13-16, 18 and 25 stand rejected under U.S.C. § 103(a) over the '647 reference; and claims 6-9 stand rejected under U.S.C. § 103(a) over the '647 reference in view of Boyd (U.S. Patent No. 5,708,421). In the discussion set forth below, Applicant does not acquiesce to any rejection or averment in the instant Office Action unless Applicant expressly indicates otherwise.

Applicant respectfully maintains that the § 102(e) and § 103(a) rejections are improper because the cited portions of the '647 reference do not correspond to the claimed invention. In particular, the Examiner's assertion that the modulated n-bit burst command word of the '647 reference (*see, e.g.*, Col. 8: 45-61) corresponds to Applicant's output audio signal, which is a combination of two separate signals (*i.e.*, an input audio signal and an identification signal that identifies an acoustic source), is improper. Notwithstanding, in an effort to facilitate prosecution, Applicant has amended various claims to recite that the identification signal distinguishes the acoustic source from other acoustic sources and that the remote control device uses the identification signal to distinguish the acoustic source from the other acoustic sources. The '647 reference does not teach or suggest that implantable system 10 (*i.e.*, the asserted remote control device) can distinguish the signals sent by one remote control unit 30 (*i.e.*, the asserted acoustic source) from the signals sent by any other remote control unit 30. *See, e.g.*, Figure 3, Col. 2:64 to Col. 3:9, Col. 6:33-61 and Col 8:14-21. Applicant has also amended several dependent claims to include at least two acoustic sources that each combine different identification signals with the input audio signal and to include that the remote control device distinguishes these acoustic sources from each other based on the different identification signals. Applicant submits that no such teachings are present in the '647 reference. Many of these distinguishing arguments were discussed in detail in the Response dated April 16, 2009 (hereby incorporated by reference in its entirety). Accordingly, the § 102(e) and § 103(a) rejections are improper and Applicant requests that they be withdrawn.

Applicant respectfully maintains that the § 102(e) and § 103(a) rejections of various dependent claims are improper for various other reasons, as is discussed in detail below.

Regarding claims 5-9 and 23-25, the '647 reference further fails to correspond to aspects of the claimed invention directed to determining the distance between the acoustic source and the remote control device. The cited portions of the '647 reference simply discuss the distance over which the implantable system 10 and the remote control unit 30 can communicate with each other (*e.g.*, up to 45-60 cm); however, there is no mention of determining what the actual distance is between the implantable system 10 and the remote control unit 30 based on the signals sent between the devices. *See, e.g.*, Col. 5:48-60 and Col. 6:20-24. Accordingly, the rejections of claims 5-9 and 23-25 are improper and Applicant requests that they be withdrawn.

Regarding claims 10-11 and 24, the '647 reference further fails to correspond to aspects of the claimed invention directed to controlling the volume of the output audio signal responsive to a change in the distance between the acoustic source and the remote control device. As noted above, the '647 reference does not teach or suggest determining what the distance is between the implantable system 10 and the remote control unit 30. Moreover, the '647 reference also does not teach controlling the volume of the signal output by remote control unit 30 over signal path 32 in any manner, let alone controlling the volume responsive to a change in the distance between the implantable system 10 and the remote control unit 30. Accordingly, the rejections of claims 10-11 and 24 are improper and Applicant requests that they be withdrawn.

Regarding claims 11, 13-16, 18 and 25, the Examiner improperly relies upon Official Notice without providing documentary evidence to support the various conclusions upon which the rejections are based. *See, e.g.*, M.P.E.P. § 2144.03 ("While "official notice" may be relied on, these circumstances should be rare when an application is under final rejection ... It would not be appropriate for the examiner to take official notice of facts without citing a prior art reference where the facts asserted to be well known are not capable of instant and unquestionable demonstration as being well-known."). Thus, Applicant requests that the Examiner provide documentary evidence to support the conclusions in the instant Office Action that various aspects of claims 11, 13-16, 18 and 25 are well-known. Without such evidence, the § 103(a) rejection of claims 11, 13-16, 18 and

25 must be withdrawn. Applicant submits that further discussion regarding the impropriety of this rejection is unnecessary at this time in view of the clear lack of correspondence between the '647 reference and the claimed invention as discussed above.

At best, and to the extent that a skilled artisan might be led to modify the '647 reference with the cited teachings of the '421 reference, these references teach away from the combination asserted in the Office Action. For example, because the '647 reference does not discuss the above noted aspects of the remote control unit 30, these references would suggest not using any such remote control. Should the Examiner provide the relied upon documentary evidence to support the conclusion and/or should these rejections be maintained, Applicant would gladly elaborate. In *KSR*, the Supreme Court looked favorably on *Adam's* treatment of teaching away stating, "when the prior art teaches away from combining certain known elements, discovery of a successful means of combining them is more likely to be non-obvious." The Court further tied in the relationship between the teach-away standard and demonstrating unpredictable results. "The fact that the elements [in *Adams*] worked together in an unexpected and fruitful manner supported the conclusion that Adam's design was not obvious to those skilled in the art." *KSR Int'l Co. v. Teleflex, Inc.*, 127 S. Ct. 1727, 1742 (2007).

Applicant further traverses the § 103(a) rejection of claims 6-9 because the Examiner fails to provide a valid reason for modifying the '647 reference with the cited teachings of the '421 reference. Specifically, the Examiner asserts that the skilled artisan would modify the '647 reference in view of the '421 reference to apparently allow for tracking of the '647 reference's implantable system 10. However, the implantable system 10 and the remote control unit 30 of the '647 reference can only communicate with each other over a distance of less than two feet. *See, e.g.*, Col. 5:48-60 and Col. 6:20-24. As such, Applicant submits that the Examiner's assertions that the skilled artisan would be motivated to modify the '647 reference to allow for the tracking of the implantable system 10 is wholly unsupported since the devices of the '647 reference can only communicate with each other when they are in close proximity. Accordingly, the § 103(a) rejection of claims 6-9 is improper and Applicant requests that they be withdrawn.

For the aforementioned reasons, Applicant believes that the claims should therefore be deemed patentable and requests that the rejections be withdrawn. Should the

Examiner disagree only on the basis of the claim language, Applicant requests suggestions. *See, e.g.*, M.P.E.P. § 706:

When an application discloses patentable subject matter and it is apparent from the claims and the applicant's arguments that the claims are intended to be directed to such patentable subject matter, but the claims in their present form cannot be allowed because of defects in form or omission of a limitation, the examiner should not stop with a bare objection or rejection of the claims. The examiner's action should be constructive in nature and when possible should offer a definite suggestion for correction.

In this instance, the '647 reference is completely unrelated to Applicant's invention as is readily apparent from even a cursory review of the '647 reference. Specifically, the '647 reference is directed to an implantable medical device and controlling such a device (as is shown in Figure 3), whereas Applicant's invention, in certain embodiments, is directed to an audio system (*see, e.g.*, paragraphs 0001-0004 of Applicant's specification). Applicant submits that the claims (in their current form) clearly distinguish over the '647 reference as discussed above.

In view of the remarks above, Applicant believes that each of the rejections has been overcome and the application is in condition for allowance. Should there be any remaining issues that could be readily addressed over the telephone, the Examiner is asked to contact the agent overseeing the application file, Peter Zawilski, of NXP Corporation at (408) 474-9063.

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